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OFFICE OF PETITIONS

In re Application of	:
Hinuma et al.	:
Application No. 09/207,168	: Decision on Petition for
Filed: December 7, 1998	: Patent Term Extension
Attorney Docket No. 48811	:
For: NOVEL PEPTIDES AND	:
PRODUCTION AND USE THEREOF	:

The above-identified application has been forwarded to the undersigned for consideration on the "Petition For Review of Patent Term Extension Under 37 §§ CFR 1.181, 1.701(a)(1), 1.701(c)(1)(ii), and MPEP 2720" received on February 7, 2005, for an extension of the patent term for 856-days or 756-days due to delays in the Office for suspensions for a potential interference. Further requests or a request for reconsideration of this decision for patent term extension, must be filed under 37 CFR 1.182 or 37 CFR 1.183, and include the required fee, as 37 CFR 1.701 does not apply in this situation.

The petition under 37 CFR 1.181 is dismissed.

Petitioner notes that the above-identified application was filed on December 7, 1998, and allowed on November 7, 2005, but issuance was delayed due to suspensions in prosecution for a potential interference. Petitioner states that the application was initially suspended for 6-months for a potential interference on March 5, 2003¹, and a communication mailed by the Office on March 10, 2003. Petitioner states that the application was then suspended again in response to a status inquiry on January 29, 2004 and on October 19, 2004. Petitioner states that on July 7, 2005 a Final Rejection was initialed which was mailed on July 8, 2005, which in effect terminated the suspension of prosecution. Petitioner states that the Notice of Allowance and Issue Fee Due mailed on November 7, 2005, indicated that the application is eligible for a patent term extension of 331-days.

Petitioner asserts that prosecution in the application was suspended from March 5, 2003, until July 7, 2005, the date the suspension was terminated by the Final Rejection, which gives 856 days of patent term extension. Alternatively, Petitioner asserts that prosecution in the application was suspended from March 5, 2003, until May 8, 2005, the date the A/R record was closed and the application was forwarded to the Examiner according to PAIR, which gives 796 days of patent term extension. Petitioner asserts that under 37 CFR 1.701(c)(1)(ii), the patent term should be extended for either 856 or 796 days, not 331 days as indicated on the Notice of Allowance and Issue Fee Due.

¹ March 5, 2003 is the date of counting the Office Action reflected in PAIR, the date of the Office Action.

35 U.S.C. § 154(b)(as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000.

35 U.S.C. § 154(b)(as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for these administrative delays and others in applications filed on or after May 29, 2000. The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

The above-identified application was filed on December 7, 1998. Accordingly it is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995. The provisions of 35 U.S.C. § 154(b) in effect on May 29, 2000 do not apply, because the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000. Pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, an applicant can receive patent term extension only if there was an appellate review, interference or a secrecy order delays as set forth in the statute. While petitioner argues that patent term extension should be awarded to the above identified application, both 35 U.S.C. 154(b) and 37 CFR 1.701(c)(1) require an interference proceeding under 35 U.S.C. 135(a) to be eligible for patent term extension.

Petitioner argues that under 37 CFR 1.701(c)(1)(ii); the patent term extension should be 856 or alternatively 796 days for the delay due to the suspension in prosecution due to the interference. While prosecution in the application was suspended, the suspension was due to potential interference with applicants' application with other application(s), not to await the result of an interference in another application. As a result, the provisions of 37 CFR 1.701(c)(1)(ii) do not apply. The provisions of 37 CFR 1.701(c)(1)(ii) apply to suspensions by the Office due to interference proceedings under 35 U.S.C. 135(a), however, in this instance there was no interference proceeding. Therefore, petitioners' argument that he is entitled to patent term extension for the period of suspension under 37 CFR 1.701 is not persuasive.

The Notice of Allowance and Issue Fee Due mailed on November 7, 2005, incorrectly indicated that the patent to issue from the application 09/207,168 is eligible for a 331-day extension, where no extension is due. The patent, if issued, will include an indication that the patent term is extended by (0) days.

After mailing of this decision, the above-identified application will be returned to the Office of Publications.

Petitioner's deposit account has not been charged a petition fee.

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709 (voice).



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